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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/599,575

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Rainer Barnekow

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ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.

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SUITE 600

WASHINGTON,, DC 20036

EXAMINER

SMITH, CHAIM A

ART UNIT

PAPER NUMBER

1794

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/599,575	<b>Applicant(s)</b> BARNEKOW ET AL.	
	<b>Examiner</b> CHAIM SMITH	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/02/2006</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. In amended claim 2, the phrase "the component powder" lacks proper antecedent basis. Simply because the overall composition is a powder, does not provide that each component is individually in powder form, or at least, was in powder form as an individual component prior to manufacture. Furthermore, it appears that the claims should have been amended to recite "the coffee component", instead of "the component powder".

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 - 3, 5, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Schweren DE 19500919.
6. Regarding claims 1 - 3, 5, 9, and 10 Schweren discloses a water soluble beverage powder (alcoholic instant beverage) comprising a coffee component, alcohol

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containing granules with an alcohol content of 5% by weight, a creamer, and a sweetening agent which when dissolved in water would provide a ready-to-drink coffee flavored beverage ('919; col. 1 ln 3 - 39). Further the concentration of alcohol in said ready-to-drink beverage would be dependent on the amount of powder and water used to make the beverage. Further still with respect to claim 5 it is noted that glucose is a form of sugar.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 4, 6 - 8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schweren De 19500919 in view of Villagran USPN 6,290,997.

10. Regarding claims 4, 6, and 7, Schweren does not disclose the use of glucose, coffee substitute, and vegetable fat. The milk powder of Schweren contains fat and milk protein, and Schweren discloses the use an emulsifier (pectin). Villagran discloses a

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water soluble beverage powder containing mixtures of sugar and glucose ('997; sucrose and glucose; col. 6 ln 5 – 9), instant coffee, vegetable fat, stabilizer, emulsifier, flavors, ('997; col. 2, ln 25 – 64) and coloring agents ('997; col. 21, example 9). Villagran further discloses that this composition would deliver improved mouthfeel and creaminess in a water soluble beverage powder ('997; col.1, ln 14 – 24). It therefore would have been obvious to one of ordinary skill in the art at the time of the invention to have also used glucose and vegetable fats in the beverage powder of Schweren as taught by Villagran. No unexpected result or coaction is seen from the use of the claimed ingredients for their known functions. Further the use of coffee substitutes in powdered beverages is well known in the art.

11. Applicants attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

12. Claims 6 and 7 further differ from Schweren in view of Villagran with respect to the particular amounts of ingredients used. Regarding the specific amounts of ingredients, the discovery of an optimum value of a result effective variable is ordinarily

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within the skill of the art. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). In developing a water soluble beverage powder, properties such as taste, sweetness, and flavor are important. It appears that the precise ingredients as well as their proportions affect the taste, sweetness, and flavor of the product, and thus are result effective variables which one of ordinary skill in the art would routinely optimize.

13. Schweren in view of Villagran discloses the use of 33% sugar instead of 34%, 6.5% coffee extract instead of 4%, 3% vegetable fats instead of 1%, and 3% of emulsifier instead of 0.3% ('997; col. 2, ln 25 – 64). No particular difference is seen in using only slight differences in the amounts of ingredients absent unexpected results.

14. Regarding claim 8, Schweren in view of Villagran teaches a process for the preparation of a food product in which a coffee component, alcohol containing granules containing 10 – 30% wt of alcohol, a creamer, and a sweetening agent are mixed ('919; example 1).

15. Regarding claims 11 and 12, Schweren in view of Villagran teaches the dissolution in water of a food product to produce a ready-to-drink coffee flavored beverage ('919; examples 2 – 4).

#### ***Information Disclosure Statement***

16. An information disclosure statement letter was received however no PTO-1449 was attached therefore the information disclosure statement could not be considered.

***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAIM SMITH whose telephone number is (571)270-7369. The examiner can normally be reached on Monday-Thursday 7:30-5:00.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. S./  
Chaim Smith  
Examiner, Art Unit 1794  
21 April 2009

/KEITH D. HENDRICKS/  
Supervisory Patent Examiner, Art Unit 1794